

### REMARKS

Claims 12, 17-20 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 1-5 and 8-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Admitted Prior Art ("APA"); claims 6-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over APA in view of USP 6,411,274 to Watanabe et al. ("Watanabe") and claims 17-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over APA in view of USP 5,581,678 to Kahn.

In accordance with this amendment, independent claims 1, 2, 3, and 12 have been amended to incorporate the subject matter of dependent claims 24, 23, 22 and 21, respectively, and claims 4-5, 8-12 and 17-20 have been amended to conform to their respective base claims. Claims 13-16 and 21-24 have been canceled.

Applicant respectfully requests reconsideration and withdrawal of the grounds of rejection in view of the foregoing amendments and following discussion.

Firstly, the claim amendments made herein clearly do not raise any new issue that would require further search or consideration. Instead, each of the independent claims has been further limited to include the subject matter of dependent claims, other dependent claims have been amended to

conform to the amended base claims, and eight claims have been canceled. Thus the issues left for consideration have been materially reduced and further crystallized.

**Rejection Under 35 U.S.C. §112, First Paragraph**

Claims 12 and 17-20 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for the following reasons:

(1) In claim 12, the new limitations added thereto in the clause "means for temporarily eliminating one or more of the non-selected graphs from the screen by issuing a temporary elimination command by the pointing device specifying the axes of the one or more non-selected graphs which are to be temporarily eliminated" were not described in the specification as originally filed; and

(2) In new claims 17-20, the clause "wherein the axis corresponding to the selected graph is not an axis of either a scroll bar or a scaling bar" was not described in the specification as originally filed.

Applicant respectfully traverses both grounds of rejection.

The purpose of the written description requirement of 35 U.S.C. §112, first paragraph, is to ensure that the inventor had possession of the invention as of the filing date. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). In

deciding whether or not the written description requirement has been satisfied, the content of the drawings may be considered. In re Kaslow, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

With regard to claim 12, the specification as originally filed describes on page 10, line 24 through page 11, line 5 and on page 12, lines 20-23 with reference to Fig. 4 that unnecessary data (non-selected graphs) can be temporarily eliminated from the screen by the pointing device (mouse) by moving the point of the mouse to the axial area on the display screen of the graph to be non-selected. Original claim 12 contains a similar description and refers to eliminating an unnecessary graph from the screen by means of a temporary elimination command by specifying the axes of the graph by a pointing device. It is clear, therefore, that the subject matter of claim 12 is adequately described in the specification as originally filed.

New or amended claims which introduce limitations that are supported in the specification either expressly, implicitly or inherently comply with the written description requirement. There can be no doubt that applicant was in possession of the invention recited in pending claim 12 at the time of filing of the application, and the amended specification provides direct antecedence for the wording appearing in claim 12.

With respect to claims 17-20, the specification as originally filed unquestionably supports the recitation that "the axis corresponding to the selected graph is not an axis of either a scroll bar or a scaling bar." The entire disclosure is devoted to eliminating use of scroll and scaling bars to adjust graphs on a screen and instead to use a pointing device to specify a coordinate axis of a selected graph on the screen and to use the pointing device to scroll and scale the graph. The various drawbacks of scroll and scaling bars are described in the original specification on pages 1-3, and use of a pointing device to carry out the functions of scroll and scaling bars is described throughout the specification. See, for example, the description on pages 5-6 of the specification and the detailed description of the invention.

It is clear, therefore, that the specification and drawings as originally filed adequately comply with the written description requirement and that the rejection of claims 12 and 17-20 under 35 U.S.C. §112, first paragraph, should be withdrawn.

#### **Rejections Under 35 U.S.C. §103**

Independent claims 1, 2, 3 and 12 were rejected under 35 U.S.C. §103(a) as unpatentable over APA, and dependent claims 21-24 were rejected under 35 U.S.C. §103(a)

as being unpatentable over APA in view of Kahn. Since the subject matter of dependent claims 21-24 has been incorporated into the respective base claims, only this ground of prior art rejection need be addressed.

The Examiner acknowledges that APA does not disclose selecting one graph out of a plurality of graphs displayed on a screen by specifying a coordinate axis of the selected graph by a pointing device. The sole statement concerning the rejection of claims 21-24 is that "Kahn discloses (Fig. 5A) the displaying of selected graph (505) comprises a coordinate axis (starting at the 0 coordinate) of the selected graph." Kahn admittedly shows a selected graph 505 having coordinate axes; however, there is absolutely no disclosure in Kahn of using a pointing device to specify the coordinate axis of a selected graph out a plurality of graphs displayed on a screen to select a graph to scrolled or scaled, as required by the claims. To the contrary, Kahn teaches creating a floating graph on a spreadsheet page by clicking the Graph tool 223 from the toolbar 220. Thus the combined teachings of APA and Kahn do not disclose or suggest the subject matter of independent claims 1, 2, 3 and 12. Thus the combined teachings of APA and Kahn do not disclose or suggest the subject matter of independent claims 1, 2, 3 and 12.

Moreover, none of the prior art references discloses using the pointing device for scrolling a selected graph by dragging on a coordinate axis, as recited in claims 4 and 5.

Independent claims 1, 2, 3 and 12 together with their dependent claims clearly patentably distinguish over the prior art.

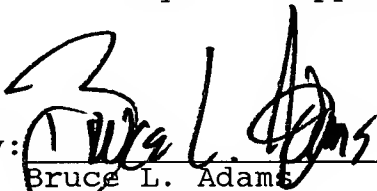
In view of the foregoing, favorable reconsideration and entry of this amendment together with passage of the application to issue are respectfully requested.

Respectfully submitted,

ADAMS & WILKS

Attorneys for Applicant

By:

  
Bruce L. Adams  
Reg. No. 25,386

50 Broadway - 31st Floor  
New York, NY 10004  
(212) 809-3700

MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: MS AF, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Debra Buonincontri

Name

  
Signature

MAY 3, 2005

Date